

maintain the retaining means in the vagina. The applicant is submitting this amended language with this response.

A Terminal Disclaimer accompanies this response. The Terminal Disclaimer is executed by an officer of the corporation to which all rights to this application and U.S. Patent Number 4,735,621 are assigned. The Terminal Disclaimer disclaims the terminal part of all claims of any patent granted on the application which would extend beyond 17 years from the issue date of U.S. Patent Number 4,735,621 which is April 5, 1988. The Terminal Disclaimer further states that any patent granted on the above-identified application shall be enforceable only for and during such period that the patent is commonly owned with U.S. Patent Number 4,735,621. The Terminal Disclaimer is executed by an officer of the corporation, Chartex International Plc., which now owns both U.S. Patent Number 4,735,621 and this application. Assignments identifying the new ownership are being executed and will be submitted for recordation in the next few weeks.

Relying on 35 U.S.C. Section 112, first paragraph, the Examiner has objected to the specification as failing to adequately teach how to make and/or use the invention. The Examiner also has rejected claims 21 through 23 and 26 for the reasons set forth in the objection to the specification. Specifically, the Examiner objects to the word "about" and the term "hand feel." The applicant respectfully traverses this objection and rejection.

The Examiner's objection regarding the word "about" is not understood. The Examiner identifies the location in the specification of the specific dimensions to which this word is applied. In other words, the Examiner notes that the invention can have a diameter between about 55 mm and about 85 mm. The word "about" indicates that the exact diameter of the device is not critical to the structure or function of the device as long as the diameter is close to the range provided. It is believed that this use of the word "about" is standard with the practice of claim drafting and is understood by one having ordinary skill in the art.

The term "hand feel" is standard within the art of polymer film chemistry. The term is placed within quotations in the application and U.S. Patent Number 4,735,621 at column 3, line 62, in order to indicate that the polymer film has a sensory characteristic of being soft and nonadhesive in one's hand. Such polymer films are known and this term is understood by one having ordinary skill in the art.

The objection and rejection should be withdrawn.

Relying on 35 U.S.C. Section 112, first paragraph, the Examiner objects to the specification for not supporting the claims as filed and has rejected claims 21 through 23 and 26. Specifically, the Examiner objects to the phrase "juxtaposed to the cervix." This phrase has been removed from the claims by this response. The objection and rejection should be withdrawn.

Relying on the judicially created doctrine of obviousness-type double patenting, the Examiner has rejected claims 21 through 23 and 26 as being unpatentable over claims 1 through 3 of U.S. Patent Number 4,735,621. The Terminal Disclaimer, as described above, is submitted with this response. This rejection should be withdrawn.

Relying on 35 U.S.C. Section 103, the Examiner has rejected claims 21 through 23 and 26 as being unpatentable over Graham in view of Dyck, et al. The applicant respectfully traverses this rejection.

The Examiner relies upon Graham primarily for its "element 1" which is a band or "retaining means". This band in the Graham device is located approximately equidistant between the open and closed end of the tube. The ring is placed in the center of the tube in order to form the "bag-like extension 3" at the closed end of the tube. The bag-like extension 3 of the Graham "animal breeder bag" is critical to the function of the device. This is because the bag-like extension 3 is the pouch or bag within which animal semen is collected. This function cannot be provided by the Graham invention if the retaining means is in the closed end of the tube or bag of the Graham device.

The applicant has amended his independent claims to recite that the "means for retaining" is in the closed end of the tube and has a diameter sufficient to retain the tube in the vagina. The placement of the "means for retaining" in the closed end of the tube provides the applicant's device with the unexpected

result that the penis, during coitus, moves against the internal wall of the tube. This internal wall of the tube during coitus is unincumbered by any ring such as element 1 of the Graham device. Such a structure permits a natural sensation to occur during coitus.

The Dyck, et al. patent is relied upon by the Examiner only for its disclosure of a method for making a condom from polyurethane. This disclosure, in combination with the Graham patent, does not provide nor make obvious a structure having a "means for retaining" in the end of the tube, as claimed by the applicant, or the unexpected results of the applicant's invention as described above.

This rejection should be withdrawn.

For the reasons discussed above, the applicant respectfully submits that his application is now in condition for allowance. Favorable consideration of this application in light of the above amendments and remarks is requested. If any fees are required and not provided by this response, please charge our Deposit Account No. 12-1210, and notify us accordingly.

Respectfully submitted,

20 Feb 90

Date



Paul Grandinetti  
Registration No. 30,754  
LEVY, ZITO & GRANDINETTI  
1511 K Street, N.W.  
Suite 425  
Washington, D.C. 20005  
Telephone: (202) 429-4560  
Telefacsimile: (202) 429-4564

PG:csh